

Serial No. 10/698,737  
Reply to Office Action of 04/14/2004

### REMARKS

Responsive to the Office Action mailed April 14, 2004, Applicants have studied the Examiner's comments and the cited art. Claims 1-7 are currently pending. In view of the following remarks, Applicants respectfully submit that the application is in condition for allowance.

#### Claim Rejections – 35 U.S.C. § 112

Claims 2 and 8 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention subject matter. Examiner suggested that Applicant include the distinctive peaks in the claims obtained by the XRD powder pattern given in Figure 5. However, MPEP § 2174.05(s) states that "incorporation by reference to a specific figure or table 'is permitted only in exceptional circumstances where there is no practical way to define the invention in words and where it is more concise to incorporate by reference than duplicating a drawing or table into the claim.'" Applicant respectfully submits that claim 2's incorporation of Figure 5 by reference is an exceptional circumstance, because there is no practical way to define the XRD powder pattern of solvated form V in words and it is more concise to incorporate by reference than to duplicate the XRD powder pattern figure into claim 2. As per MPEP § 2174.05(s), Applicant emphasizes that incorporation of a figure by reference is a necessity in this application and is not for the convenience of Applicant. Nevertheless, applicant has attempted to discern precise values for the XRD peaks of Figure 5 and embody them in new claim 12.

By the above discussion, it is believed that the 35 U.S.C. § 112, second paragraph, rejection has been overcome. Applicant respectfully requests that the Examiner withdraw his 35 U.S.C. § 112, second paragraph, rejection of claim 2.

The rejection of claim 8 under 35 U.S.C. § 112, second paragraph, is now moot in view of the cancellation of claims 8-11.

#### Double Patenting

All pending claims were provisionally rejected under 35 U.S.C. § 101 for statutory double patenting. Pending independent claim 1 has been amended so that it is no longer coextensive in scope with the claims of U.S. Patent 6,727,363 (previously co-pending Application No. 10/239,636). The pending independent claim 1 has been amended to cover a process for producing crystalline Form I of cabergoline with a purity >95%. This amendment to pending independent claim 1 changes the scope so that the pending claims 1-7 are no longer coextensive in scope with any of the claims in U.S. Patent 6,727,363, which had no such purity aspects.

By the above-discussed amendment, it is believed that the 35 U.S.C. § 101 rejection of statutory double-patenting has been overcome.

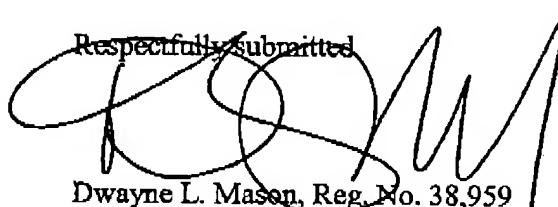
The rejection of claims 8-11 under 35 U.S.C. § 101 is now moot in view of the cancellation of these claims.

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### CONCLUSION

Applicants respectfully submit that all issues and rejections have been adequately addressed, that all claims are allowable, and that the case should be advanced to issuance.

If the Examiner has any questions or wishes to discuss the claims, Applicants encourage the Examiner to call the undersigned at the telephone number indicated below.

Respectfully submitted  
  
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Date: 8/16/04

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